



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/507,360 | 02/18/2000 | David Richard Gottstein | 3753/6 US | 8391 |

29858 7590 08/25/2003

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP
900 THIRD AVENUE
NEW YORK, NY 10022

| |
|----------|
| EXAMINER |
|----------|

BASHORE, ALAIN L

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,360

Applicant(s)

GOTTSTEIN, DAVID RICHARD

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The related application listed on page one must include the fact that it is now a U.S. patent with serial number listed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 15, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is recited in claims 4, 15, and 26 a trademark of a product. Since the product may change from time to time, the claims reciting the trademark are indefinite. The word "based" is considered indefinite as a relative term because the meets and bounds are unknown. The recitation of a particular corporation that the trademarked product is available from is considered indefinite since corporate ownership / availability may change over time.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 9, 12, 16, 19, 21, 23, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al.

Frank et al discloses a computerized method for optimizing investments. Tax and investment data is received corresponding to a plurality of investments. There are received user-customized investment expectations (col 5, lines 40-45). A comparative tax sensitivity analysis of the tax and investment data and the analyzed investment expectations are performed (col 10, lines 56-67; col 11, lines 1-6). There is outputted a set of financial investment data, including money valuations, representing an optimal after-tax investment strategy path from a plurality of investment paths over the dynamic taxation time range (col 1, lines 49-55). The investments may be bonds (col 5, lines 49-50). An input window is displayed on the user interface (fig 6).

There is not explicitly disclosed:

“lot-by-lot” basis or taxable “lots”;

derivative rights; and,
comparative pro-forma

Wallman discloses lots (col 1, lines 30-67; col 2, lines 1-21) and derivative rights (col 15, lines 15-23).

It would have been obvious to one with ordinary skill in the art to include a lot-by-lot basis including taxable lots to Frank et al because Wallman teaches that considerations of lots have important consequences for investors.

It would have been obvious to one with ordinary skill in the art to include derivative rights to Frank et al because Wallman teaches such a type of investment (col 15, line 15).

Kiron et al discloses comparative pro-forma (see abstract).

It would have been obvious to one with ordinary skill in the art to include comparative pro-forma to Frank et al in view of Wallman because Kiron et al teaches dissemination requirements to relevant parties (dissemination to shareholders).

6. Claims 2-4, 6, 13-15, 17, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al as applied to claims 1, 5, 12, 16, 21, 23, 27-30 above, and further in view of Reed et al.

Frank et al in view of Wallman in further view of Kiron et al does not disclose:

a spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid; and,
a Lotus 1-2-3 spreadsheet.

Reed discloses a spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid and Lotus 1-2-3 (col 1, lines 9-49).

It would have been obvious to one with ordinary skill in the art to include spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid to Frank et al in view of Wallman in further view of Kiron et al because Reed et al teaches spread sheets as useful and including as typical formulas, cells and grids (col 1, lines 13-42).

It would have been obvious to one with ordinary skill in the art to include a Lotus 1-2-3 spreadsheet to Frank et al in view of Wallman in further view of Kiron et al because Reed et al teaches such as common (col 1, line 9-10).

8. Claims 7-11, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al as applied to claims 1, 5, 12, 16, 21, 23, 27-30 above, and further in view of Howard et al.

Frank et al in view of Wallman in further view of Kiron et al does not disclose:

a GUI;

network-based entry window; and,

browser interfacing with server through the Internet or Intranet.

Howard et al discloses GUI (para 0027), network-based entry windows (para 0014), and browser interfacing with server through the Internet or Intranet (para 001).

It would have been obvious to one with ordinary skill in the art to include a GUI to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches GUIs as common.

It would have been obvious to one with ordinary skill in the art to include a network-based entry window to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches such as to allow sensitive information.

It would have been obvious to one with ordinary skill in the art to include a browser interfacing with server through the Internet or Intranet to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches Internet use for information dissemination and that browser are common for this usage (para 003 and para 0011)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jones et al discloses an financial advisory system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.


Alain L. Bashore